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OFFICE OF PETITIONS

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In re Application of Liang et al.	:	
Reissue Application No. 09/637,764	:	
Reissue Filing Date: August 10, 2000	:	Decision on Petition
Reissue of Patent No. 5,791,422	:	
Original Issue Date: August 11, 1998	:	
Attorney Docket No. 36912/S61	:	

This is a decision on the petition under 37 C.F.R. § 1.47(a) filed October 13, 2011, which is being treated as a renewed petition under 37 C.F.R. § 1.183 seeking waiver of 37 CFR §§ 1.172 and 1.175 to the extent these regulations require a supplemental declaration in a reissue application be executed by all the named inventors.

The petition under 37 C.F.R. § 1.183 is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.183."

Background

A paper labeled as a petition under 37 C.F.R. § 1.47(a) was filed March 3, 2011.

The Office treated the March 3, 2011 petition as a petition under 37 C.F.R. § 1.183 and mailed a decision dismissing the petition on May 12, 2011.

The May 12, 2011 decision stated,

Each declaration filed March 3, 2011, is titled, "Substitute Declaration for Reissue Application." Therefore, the Office has assumed the declarations are not intended to be supplemental declarations, which only seek to correct the errors statement in a prior declaration.

Based on the Office's review of the record and the efforts made to obtain the signature of the non-signing inventor, the Office would normally conclude justice would be served by

waiving the requirement for his signature on the substitute declaration filed March 3, 2011. Unfortunately, the petition cannot be granted at this time because the substitute declaration is improper.

The instant petition was filed October 13, 2011, and is labeled as a petition under 37 C.F.R. § 1.47(a). The petition does not include any reference to the May 12, 2011, and the decision is almost identical to the petition filed March 3, 2011.

The only significant differences between the second petition, filed October 13, 2011, and the first petition, filed March 3, 2011, appear to be:

1. The second petition is dated October 13, 2011, not March 3, 2011;
2. The second petition includes a statement by Inez Cameron setting forth facts involving inventor Fang's refusal to sign a supplemental declaration; and
3. The second petition includes *supplemental* declarations signed by three of the four inventors with dates of execution after March 3, 2011.

Discussion

The May 12, 2011 decision stated,

Each declaration filed March 3, 2011, is titled, "Substitute Declaration for Reissue Application." Therefore, the Office has assumed the declarations are not intended to be supplemental declarations, which only seek to correct the errors statement in a prior declaration.

Each declaration filed with the second petition is titled "Supplemental Declarations for Reissue Declaration." The Office is interpreting the new title as an indication the declarations are being submitted as supplemental declarations, not substitute declarations.

A review of the record indicates the reissue supplemental declarations filed with the second petition are improper.

The Manual of Patent Examining Procedure ("MPEP") § 1414.01(III) (8th ed., Rev. 8, July 2010) states, with emphasis added,

If a joint inventor refuses or cannot be found or reached to sign a supplemental oath/declaration, a supplemental oath/declaration *listing all the inventors*, and signed by all the available inventors may be filed provided it is accompanied by a petition under 37 CFR 1.183 along with the petition fee, requesting waiver of the signature requirement of the nonsigning inventor.

As set forth in the language directly above, the supplemental oath or declaration must list all of the inventors. The inventors of record are (1) Dah-Ben Liang, (2) Jiinjen Albert Sue, (3) Alysia C. White, and (4) Zhigang Fang.

None of the signed declarations filed with the second petition list all four inventors. Specifically,

1. Although the heading of the declaration signed by Liang lists the "Patentee" as "Dah Bien Liang, et al.," the declaration only identifies Liang as an inventor;
2. The declaration signed by Sue directly identifies Sue as an inventor, indirectly identifies Liang as an inventor,¹ and fails to list White or Fang as inventors; and
3. The declaration signed by White directly identifies White as an inventor, indirectly identifies Liang as an inventor, and fails to list Sue or Fang as inventors.

Since each of the signed declarations fails to identify all four inventors, the declarations are improper and the petition is dismissed.

Any request for reconsideration should include a supplemental declaration listing all four inventors signed by Liang, Sue, and White. As a courtesy, the Office notes a PDF "fillable" form, which only seeks to correct the errors statement in a prior declaration, can be on the Office's website at: <http://www.uspto.gov/forms/sb0051s.pdf>.

The second petition includes a payment of \$200 for a petition fee. However, since the petition is being treated as a renewed petition under 37 C.F.R. § 1.183, a new petition fee is not required and the \$200 has been refunded to the deposit account used to pay the fee.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.² Document Code "PET.OP" should be used if the request is filed electronically.

By facsimile: (571) 273-8300
Attn: Office of Petitions

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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Office of Petitions

¹ The heading of each declaration lists the "Patentee" as "Dah Bien Liang, et al."

² General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.